

Application Serial No. 10/508,885
Reply to Office Action of July 9, 2009

OCT 09 2009 PATENT
Docket: CU-3914

REMARKS

In the Office Action, dated July 9, 2009, the Examiner states that Claims 1-13 and 15 are pending, Claims 1-4 are withdrawn, and Claims 5-13 and 15 are rejected.

Rejection under 35 U.S.C. §112

Claims 5-13 and 15 are rejected under 35 U.S.C. §112, first paragraph, because the Office Action considers that they fail to comply with the written description requirement. Specifically, the Office Action considers that the claims contain new matter, or subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time of application was filed, had possession of the claimed invention. The matter in issue is the combination of "a width of the non-spread portion is less than 10mm" and "a length of the hard edge part in directions of a width thereof on a cross section thereof in directions of a width of a hardened plaster board after drying in step (g) is about 0.1 mm to about 15.0 mm" as recited in current Claim 5. Applicant respectfully disagrees with and traverses this rejection.

More specifically, when "the slurry for application for the non-spread portions in step (c) conducted prior step (g) is applied to outsides of scoring lines of the front surface covering base paper" and "(g) folding the front surface covering base paper" is conducted as recited in currently pending Claim 5, the directions of "a width of the non-spread portion" as recited in currently pending Claim 5 should not be identical to (or should rather be different from) the "directions of a width of a hardened plaster board after drying up in step (g)" as recited in currently pending Claim 5 and "the slurry for application for the non-spread portions" as recited in currently pending Claim 5 should generally have a fluidity as taught by the descriptions at lines 8 to 15 on page 29 of the specification as originally filed and may also extend and/or flow in the "directions of a width of a hardened plaster board after drying up in step (g)", so that "a length of the hard edge part in directions of width thereof on a cross section thereof in directions of a width of a hardened plaster board after drying up in step (g)" should not necessarily correspond to "a width of the non-spread portion."

Accordingly, even if "the slurry for application for the non-spread portions in step (c) conducted prior step (g) is applied to outsides of scoring lines of the front surface covering base paper" and "a width of the non-spread portion is less than 10mm" as recited in currently pending Claim 5, "the slurry for application for the non-

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spread portions" may also extend and/or flow in the "directions of a width of a hardened plaster board after drying up in step (g)" when "the slurry for application for non-spread portions" "is applied to outsides of scoring lines of the front surface covering base paper" and "(g) folding the front surface covering base paper" is conducted, so that "a length of the hard edge part in directions of a width thereof on a cross section thereof in directions of a width of a hardened plaster board after drying up in step (g)" may be more than "a width of the non-spread portion" that "is less than 10mm" and accordingly it should be possible to attain a feature of "a length of the hard edge part in directions of a width thereof a cross section thereof in directions of a width of a hardened plaster board after drying up in step (g) is about 0.1 mm to about 15.0 mm" in currently pending Claim 5.

Thus, Applicant respectfully asserts that it would be possible for one skilled in the relevant art to understand that it is possible to attain a feature of "a length of the hard edge part in directions of a width thereof on a cross section thereof in directions of a width of a hardened plaster board after drying up in step (g) is about 0.1 mm to about 15.0 mm" as recited in currently pending Claim 5 even when "a width of the non-spread portion is less than 10mm." As such, Applicant respectfully asserts that it is possible for one reviewing the present application to find support for the combination of features of "a width of the non-spread portion is less than 10mm" and "a length of the hard edge part in directions of a width thereof on a cross section thereof in directions of a width of a hardened plaster board after drying up in step (g) is about 0.1 mm to about 15.0 mm" as recited in currently pending Claim 5 when referring to, at least, the specification as filed which discloses the features of "a width of the non-spread portion is less than 10 mm" and "a length of the hard edge part in directions of a width thereof on a cross section thereof in directions of a width of a hardened plaster board after drying up in step (g) is about 1.0 mm to about 15.0 mm" as recited in currently pending Claim 5.

Consequently, Applicant respectfully asserts that the combinations of features of "a width of the non-spread portion is less than 10 mm" and "a length of the hard edge part in directions of a width thereof on a cross section thereof in directions of a width of a hardened plaster board after drying up in step (g) is about 0.1mm to about 15.0 mm" as recited in currently pending Claim 5 should not be rejected as corresponding to new matter or subject matter which was not described in the

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specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claim invention.

Accordingly, reconsideration and withdrawal of the above-mentioned claim rejection under 35 U.S.C. 112, first paragraph, is respectfully requested.

Rejections under 35 U.S.C. §103(a)

Claims 5-13, 15 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japan 808 (JP 08-112808) (D1) in view of Sucech et al. (US 5,683,635) (D2), Hauber et al. (US 6,878,321) (D3), Birdsey (US 1,514,827) (D4) and Ferguson (US 5,799,458) (D5) for the reasons of record. Applicant respectfully disagrees with and traverses these rejections.

More specifically, Applicant respectfully asserts that D1 as well as D2, D3, D4 and D5 fail to teach or suggest the combination of features of "a width of the non-spread portion is less than 10mm" and "a length of the hard edge part in directions of a width thereof on a cross section thereof in directions of a width of a hardened plaster board after drying up in step (g) is about 0.1 mm to about 15.0 mm and a shape thereof is a triangular shape, a crescentic shape, an L-shape, or a J-shape" as recited in currently pending Claim 5.

In particular, the Office Action, at lines 4 to 5 on page 15, states that "It is noted that claim 5 read on the width of the hard edge being less than equal to the width of the non-spread portion." Applicant respectfully disagrees because "a length of the hard edge part in directions of a width thereof on a cross section thereof in directions of a width of a hardened plaster board after drying up in step (g)" as recited in currently pending Claim 5, as mentioned above.

Furthermore, the Office Action states, at lines 10 to 13 on page 15, that "When using a non-spread portion of less than 10 mm, the hard edge part must have a width of less than 10mm." Applicant respectfully disagrees because "a length of the hard edge part in directions of a width thereof on a cross section thereof on a cross section thereof in directions of a width of a hardened plaster board after drying up in step (g)" as recited in currently pending Claim 5 may be more than "a width of the non-spread portion" as recited in currently pending Claim 5, as mentioned above.

Accordingly, Applicant respectfully asserts that there is no ground for considering that the combination of the features of "a width of the non-spread portion

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is less than 10 mm" and "a length of the hard edge part in directions of a width thereof on a cross section thereof in directions of a width of a hardened plaster mm and a shape thereof is a triangular shape, a crescentic shape, an L-shape, or a J-shape" as recited in currently pending Claim 5 may have been obvious over the disclosures of D1 as well as D2, D3, D4, and D5.

To support a *prima facie* case of obviousness, the Office Action must establish "a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007). In view of the foregoing features that are not taught or suggested in the cited prior art, Applicant respectfully asserts that a *prima facie* case of obviousness cannot presently be established.

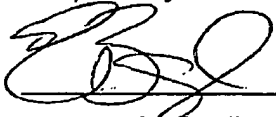
Since independent Claim 5 is allowable over the prior art, Applicant asserts that all claims depending therefrom are allowable for at least the same reasons, as well as for the features that they recite. As such, Applicant respectfully requests withdrawal of the present rejection under 35 U.S.C. §103(a).

In light of the foregoing response, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

October 9, 2009

Date

Respectfully submitted,



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